

Remarks

Entry of the above-noted amendments, reconsideration of the application, and allowance of all claims pending are respectfully requested. These amendments to the claims constitute a bona fide attempt by applicant to advance prosecution of the application and obtain allowance of all claims, and are in no way meant to acquiesce to the substance of the rejections. It is believed that the amendments made herein place the entire application in condition for allowance and/or better form for appeal. These amendments were not made earlier because the claims as previously submitted were believed to be in condition for allowance. Claims 1, 2 and 15 are amended. Claims 1-9, 11-23, 25-29 are pending. Support for the amendments can be found in the published application including paragraphs 46, 48 and 60 of the filed application.

Claim Rejections - 35 U.S.C. § 103

Claims 1-5, 8-9, 11-19 and 22-23, 25-29 were rejected under 35 U.S.C. 103(a) as being unpatentable over Crook (US 2004/0218035) in view of Soderbacka et al. (US 20030114158).

For explanatory purposes, applicant discusses herein one or more differences between the claimed invention and the Office Action's citations to Crook and Soderbacka. This discussion, however, is in no way meant to acquiesce in any characterization that one or more parts of the Office Action's citations to Crook or Soderbacka correspond to the claimed invention.

To support an obviousness rejection, MPEP §2143.03 requires "all words of a claim to be considered" and MPEP § 2141.02 requires consideration of the "[claimed] invention and prior art as a whole." Further, the Board of Patent Appeal and Interferences recently

confirmed that a proper, post KSR obviousness determination still requires the Office make "a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art." *In re Wada and Murphy*, Appeal 2007-3733, citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) and *CFMT v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003). In sum, it remains well-settled law that an obviousness rejection requires at least a suggestion of *all* of the claim elements. Because the cited art does not disclose limitations of the claimed invention, as found in Applicant's independent claims 1 and 15, the obviousness rejection is improper.

Crook is directed to a method for switching a call from a video/voice mode to a voice call and vice versa. Crook's method involves first setting up a call and then responding to a user prompt entered at the phone to switch the call from one service to another. A response to the prompt is handled at the phone as opposed to the network. Thus, Crook's invention requires no network modifications. To accomplish the call switch, the caller's phone places the first call on hold and the subscriber makes a second call to the same phone number as the first call. Paragraphs 63-65 of Crook describe the method for switching from a voice call to video/voice call. Paragraphs 66-68 describe the method for switching from a video/voice call to a voice call.

An aspect of the claimed invention found in independent claims 1 and 15 is that the call is transferred to the second subsystem after the change of service is complete. The Office relies on Crook as disclosing these limitations yet acknowledges that "Crook discloses transferring the call to the second subsystem but is silent after the change is complete, transferring the call to the second subsystem" (Office Action, pg 3). The Office then says that "Soderbacka teaches change of services ... where the mobile has to handoff from 3G WCDMA type to a 2G GSM (voice or audio) type" (Office Action, pg. 3). The cited art, however, does

not disclose that the call is transferred to the second subsystem after the change of service is complete. Further, the Office does not further explain how this limitation is met by the cited prior art. The cited prior art simply does not disclose this limitation.

Nevertheless, the Office points to paragraph 12 of Soderbacka as disclosing a change of service. This section of Soderbacka notes that transparent facsimile may be used in GSM, but not in WCDMA. Soderbacka goes on to note that "[i]f the mobile terminal is in a WCDMA coverage area, this transparent facsimile service can thus not be used without delay." (Soderbacka, paragraph 12, emphasis Applicant's). Thus, Soderbacka is merely recommending that the transparent facsimile service be used promptly before a mobile station handover to a 3G system where the service cannot be used. Soderbacka, however, does not disclose that there is a service change from one service to another as disclosed in the Applicant's independent claims. As further evidence that Soderbacka does not disclose a change of service; the claims are directed to a first service and a second service where the change of service occurs from the first service to the second service. Soderbacka only mentions one service, the facsimile service. There is no mention of a second service to change to. In short, the claims are directed to a change of service, while Soderbacka recommends merely *using* a service and does not even mention a second service. Thus Soderbacka does not mention changing from a first service to a second service, notwithstanding the missing limitation that a call transfer occurs after the change of service is completed.

The independent claims also contain a limitation that if the second subsystem is not adapted to process the call under the first service, a change of service is affected. As disclosing this limitation the examiner points to paragraph 71 of Crook. This paragraph discloses that "[a]t present, a video call can only be made when a single outgoing audio call is in

progress. If a conference call in is [sic] progress or a call is on hold, the video option will not be available. This limitation may depend on the type of network and the associated channel handling procedures." Crook discloses that a video call can only be made when a single outgoing audio call is in progress. Thus Crook does not disclose that the video call cannot be made because a subsystem is not adapted to process a call under a certain service. Crook discloses that the call cannot be processed because a capacity issue is reached. The system of Crook is still adapted to process video calls (a service) and audio calls (another type of service), it just cannot process the video call when more than one audio call is underway. Thus Crook and the other cited art does not disclose the limitation calling for a limitation that if the second subsystem is not adapted to process the call under the first service.

Still further, Crook is improperly used as §103 art against the claimed invention. Crook makes clear that "[i]t is therefore desirable to implement a mixed media, particularly audio/video, data transmission solution which does not require significant modification of the communication infrastructure" (Crook, paragraph 6). Crook further emphasizes the goal of minimal impact to the infrastructure by noting that his invention should be implemented "using substantially existing network infrastructures, that is relatively straightforward to implement" (Crook, paragraph 8). Thus Crook makes clear that a goal of its invention is to implement changes with minimal impact on the infrastructure. As previously noted, Crook's method involves setting up a call and switching from a voice call to a video/voice call by placing the original call on hold and placing a second call to a same number. This method is in line with Crook's stated goal of not affecting the infrastructure in that the disclosed method requires no changes to the infrastructure.

As MPEP § 2142.02 makes clear, "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Further, as MPEP § 2144.05 makes clear, "A *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997). As noted above, Crook teaches against changes to the infrastructure. The claimed invention, however, is directed to detecting and affecting a change of service within the infrastructure before the call is transferred to a second subsystem. Implementing this invention requires significant changes to the infrastructure. Accordingly, when considering Crook as a *whole* as required by MPEP § 2142.02, Crook's admonition to avoid infrastructure modifications would lead away from the claimed invention, because the claimed invention requires significant changes to the infrastructure. Further, Crook teaches away from the claimed invention in a material respect because Crook teaches against infrastructure changes, while the claimed invention requires significant infrastructure changes. For these reasons Crook is improperly used as §103 art against the claimed invention in violation of MPEP § 2142.02 and MPEP § 2144.05.

Further, MPEP § 2145 makes clear that "[i]t is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). As explained above, Crook teaches against making modifications to the infrastructure in implementing an invention. Soderbacka discloses a system and method for performing an intersystem handover. The invention disclosed by Soderbacka requires significant changes to the infrastructure. The disclosure found in paragraphs 57, 58, 62-67, 71, 72, 75-77, 79, 80, etc. of Soderbacka all require modification to some portion of the infrastructure. Thus,

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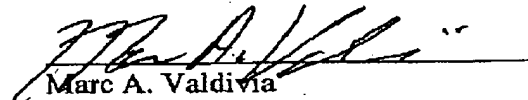
Soderbacka's requirement for significant infrastructure modification is at odds with Crook's teaching of insubstantial infrastructure changes. Thus Crook teaches away from combination with Soderbacka in violation of MPEP §2145.

Still further the Applicant has added the claim limitation that a change in codec is affected before a call is transferred. This limitation is not found in the cited prior art.

Withdrawal of the §§ 103 rejections is therefore respectfully requested.

In view of the above remarks, allowance of all claims pending is respectfully requested. If a telephone conference would be of assistance in advancing the prosecution of this application, the Examiner is invited to call applicant's attorney.

Respectfully submitted,


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